

**REMARKS**

This is in full and timely response to the Office Action mailed on October 28, 2005. Reexamination in light of the amendments and the following remarks is respectfully requested.

The courtesy of the examiner for his thorough treatment of the pending claims in this application is acknowledged with appreciation. It is noted that no art-based rejections are presented; rather, only double patenting rejections are made based on two newly-cited patents that are both assigned to the assignee of this application, Sony Corporation. In this respect, the parent patent is now mentioned in the amended text at page 1 of the specification. It may be noted that a Terminal Disclaimer for the parent patent, No. 6,683,846 issued on January 27, 2004 based on an application actually filed in the U.S. on December 8, 2000.

This will confirm that for purposes of compliance with 37 C.F.R. 1.130(b), this application, its parent patent and newly-cited U.S. Pat. Nos. 6,934,224, issued on August 23, 2005 based on an application filed on June 29, 2000, and 6,552,968, issued on April 23, 2003 based on an application filed on July 7, 2000. Neither of these two citations is available as a reference under 35 USC 102 or 35 USC 103.

**Rejection of claim 19 and 34**

Claims 19 and 34 apparently include limitations already found in their base claims 9 and 24 respectively. Appreciation is expressed to the examiner for his thorough review of the limitations of the claims. To overcome this rejection, claims 19 and 34 are respectively canceled, with prejudice or disclaimer.

Double Patenting RejectionsObviousness type double patenting rejections and submission of two Terminal Disclaimers

The paragraph entitled "Double Patenting" on page 2 of the Action seems to invite a timely filed Terminal Disclaimer to overcome a rejection founded on a non-statutory double patent rejection. Accordingly, two separate Terminal Disclaimers are submitted referring to the two newly-cited patents assigned to the assignee of this application. Thus, it is submitted that all double patenting rejections are overcome.

As to the double patenting rejections in sections 3, 4, 5, 6, 7, 8, 9, 10, 11, and 12, each appears to clearly be intended to be stated as an obviousness type double patenting rejection based on secondary references to Maeda, Mori, and Official Notice. As such, to expedite prosecution, it is clear that the double patenting rejections thus stated are overcome by the two Terminal Disclaimers submitted.

It is noted however, that for each of the double patenting rejections stated, it is not clear what differences in what pending claims are not found in what claims of the '224 or '968 patents, sufficient to turn to the disclosures of Maeda, Mori, or Official Notice, in the absence of a mapping of each of the claims presented relative to certain claims of either of the '224 or '968 patents, language. For example, in section 4 of the rejection, the examiner first refers to section 1 relying on a rejection based on certain claims of the '224 patent, then refers to claims 5 to 7, 25, 26, and 35 to 38 as being taught by the prior art. What seems to have been intended is that each of these rejected claims that has an alleged parallel in the '224 patent has a difference and that that claimed difference is made obvious by cited art. Yet, language such as used in the conclusory paragraph of that section seems possibly to refer to the disclosure of this application (obvious to modify the base system) with an alleged motivation.

It is submitted, however, that it is not necessary to discuss in detail each of the obviousness type double patent rejections because of the timely filed Terminal Disclaimers mentioned above. Suffice it to say that each of the double patenting rejections is not properly

stated or mapped as to the claims rejected, and in that respect each is traversed without acquiescence in or agreement with the statement of the rejection presented.

Because the double patenting rejections are characterized as non-statutory, MPEP 804 II B (Eighth Edition) at pp. 800-21 et seq.

Double Patenting Rejections as Stated in Sections 1 and 2 of the Action at pages 2 through 8.

These double patenting rejections are, it is submitted, also overcome by the two Terminal Disclaimer submitted with this response in the belief that obviousness type double patenting rejections are in fact stated, not same invention type double patenting rejections. This argument is presented because of the language used to the effect that “the subject matter claimed is “fully disclosed” in the patent, whereas the disclosure of the patent is not available as a patent-defeating reference for the claims noted.

At the outset, it is noted that the language used in introducing the rejection sounds like that suggested for MPEP 804 in Form Paragraph 8.38 at page 800-27 of the Eighth Edition of the MPEP. However, if this is intended, then approval from the TC Director must be obtained; it is requested that such approval be supplemented for the Office Action if this kind of double patenting rejection is intended. Even there, it is noted that the “fully disclosed in” language refers to the claims of the cited prior patent, not to its disclosure. See also the terminal sentence in the rejection referring to In re Schneller, another reason suggesting confusion in the statement of the rejection.

There is some difficulty understanding this double patenting rejection precisely in that the rejected claims in sections 1 and 2 respectively are compared to the claims of the ‘244 patent and the ‘968 patent. But it is not clear that the rejections are well founded based on a single claim of the cited patent. For example, in rejecting claim 2 of the pending application, reference is made to the ‘224 patent at claim 1, line 1 and claim 3 of the ‘224 patent. This means that no rejection is in fact made on the basis of claim 1, but rather only claim 3. Yet, reference is made to lines 2 to 6, but only lines 2 and 3 exist for claim 3 of the ‘224 patent. And, even more significantly, the claim does not meet the preamble of the pending claim and its first paragraph.

Note also that a limitation is considered “inherent”, where the pending claim refers to the “distance between the focusing element. To resort to this finding means that the limitation is not claimed in the ‘224 patent, so that the recitation itself is sufficient under double patenting to constitute an obviousness type double patenting rejection. To continue with examples, the rejection of pending claim 24, claims 1, 3, and 2 of the ‘224 patent; since claims 2 and 3 are each dependent on claim 1 of the patent, this statement is improper.

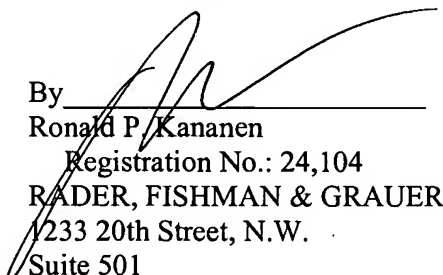
To summarize, however, the difficulties with the pending claims recited in sections 1 and 2 of the stated double patenting rejections as stated are: (1) the rejected claims would “improperly extend” the “right to exclude” in the cited patent; and (2) an absence of an apparent reason why such claims were not previously presented. Each reason is responded to by the entry of a Terminal Disclaimer.

The foregoing reasoning also applies to the rejection in section 2 based on the ‘968 patent, where sometimes several claims are referred to in the same claim mapping, and where “inherent” is advanced as a reason for claim limitation identity.

Withdrawal of all double patenting rejections is appropriate and requested.

Dated: January 13, 2006

Respectfully submitted,

By   
Ronald P. Kananen  
Registration No.: 24,104  
RADER, FISHMAN & GRAUER PLLC  
233 20th Street, N.W.  
Suite 501  
Washington, DC 20036  
(202) 955-3750  
Attorney for Applicant